

REMARKS

Claims 1-11 stand rejected as being unpatentable over Wafer (US 5,404,615) in view of White, Jr. (US 4,956,167) and in further view of Thompson (US 4,103,868). The Examiner's rejections are traversed for the following reasons.

The Examiner has cited Wafer as disclosing a valve assembly comprising a valve body having a rotary driven valve member and a valve stem, a valve handle 10 connected to the valve stem 14 having a proximal end 16 and a distal end 18 with a longitudinal axis extending between the ends, the distal end having an opening 26 that is adapted to receive a drive head 16 of a handle 100. The Examiner has noted that the Wafer device lacks the valve handle connected to the valve stem at a proximal end of the handle and the opening oriented generally transverse to a length direction of the handle, as required by the claimed invention. Initially it is noted that the element 14 is not the valve stem, but rather is the hub of the handle 10. Further, and as will be further discussed hereinafter, Wafer also fails to disclose the "handle 10" as being directly affixed to the valve stem, but rather teaches a handle that can fit over a handwheel of a gate valve (see background of invention).

The Examiner has cited White as teaching a ratchet handle 20 having a proximal end 25, a distal end 25 with a square or hexagonal opening 27 adapted to receive a ratchet handle 22 with the opening generally transverse to the length direction of the handle that is selectively repositionable to establish a desired angular relationship from zero to ninety degrees, between the ratchet handle and the valve handle.

From this, the Examiner has concluded that it would have been obvious to one skilled in the art to use the ratchet handle of White in place of the handle

assembly of Wafer.

The Examiner has further noted that Wafer and White fail to teach a rotary valve member (page 3, first line of Office action), and has cited Thompson as providing the rotary valve member. The Examiner has concluded that modifying the Wafer-White combination to include the rotary valve of Thompson would have been obvious because Wafer states "which is detachably connected with the valve stem and a shear pin assembly of a valve (not shown), as is well known in the art." The Examiner's reading of, and reliance upon, this section of Wafer is unclear to the undersigned, especially when this passage is read in context and in light of the problem being solved by Wafer (to turn a handwheel). The Examiner's rejections are traversed for the following reasons.

With reference to amended independent claim 1, it is noted that the valve handle has a proximal end that is "directly affixed" to the valve stem. The Wafer patent teaches a handle assembly having a 'centrally located hub section 14' that is adapted to be secured over a rotary handle of a valve. The rotary handle would be received in the space shown in phantom in Fig. 1, which is provided by the hub of the handle assembly. Accordingly, Wafer teaches securing a center portion of the handle assembly to the valve handle and does not teach directly affixing a proximal end of the valve handle to the valve stem, as required.

The White patent does not remove the deficiencies of the base Wafer patent. Initially, it is noted that White is not concerned with 'valve assemblies' or 'valve handles' or valve operating methods, as is the subject matter of the present invention. Rather, White is concerned with a wrench set wherein handles can be serially connected to one another.

In the Office action it appears that the Examiner proposes to replace the

Wafer handle or series of handles (i.e., Fig. 8) with the White handle/series of handles. It is respectfully submitted that even if the references were combined in this manner, the presently claimed invention would not result. Clearly, neither Wafer nor White teach "a valve handle having a proximal end, a distal end, and a longitudinal axis, said longitudinal axis extending between said proximal and distal ends, said proximal end being directly affixed to said valve stem" as required. As acknowledged by the Examiner, the Wafer patent does not teach these features of the invention. The White patent is not related to valve handles and, therefore, cannot teach this missing element of Wafer. Notably, there is no place to connect the White wrench set to the Wafer 'valve'. Accordingly, it is submitted that one would not be motivated to combine the references in a manner that would render the combination inoperable. Moreover, the total lack of suggestion or motivation in the references to combine the references supports applicant's position that the invention is patentable over the proposed combination.

The citation of Thompson as teaching a rotary valve member does not remove the deficiencies of the Examiner's base combination of Wafer and White.

As noted in the previous response, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20

USPQ2d 1438 (Fed. Cir. 1991).

It is respectfully submitted that there is no motivation or suggestion to combine the references in the manner proposed by the Examiner. Why would someone skilled in the art of gate valves when trying to solve problems associated with turning of the handwheel, such as taught by Wafer, look to the wrench set of White, Jr., to develop a new handle, and then replace the gate valve with the ball valve of Thompson? Clearly, the wrench set of White is not functional to turn the Wafer gate valve. Further, it is noted that the problems encountered in Wafer (which has a centrally disposed rotational moment (valve handle)) are completely from the problems encountered in White, Jr. (a wrench set with a distally-disposed rotational moment). Accordingly, it is considered apparent that one skilled in the art would not be motivated, based upon the teachings of the cited prior art, to combine the references in the manner required to arrive at the claimed invention. The fact that the resulting product (i.e., the claimed invention) would be better is not motivation to support the combination. Obviously, if this were the case then no 'improvement' would ever be patentable.

The foregoing arguments for patentability are equally applicable to all of the independent claims of the present application and, for purposes of brevity, will not be repeated hereinafter.

In light of the foregoing, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the Examiner is urged to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please

charge same to our Deposit Account No. 18-0160, our Order No. GRO-12525.

Respectfully submitted,

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